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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,789	06/22/2001	Michael P. Whitman	11443/56	7650

26646 7590 12/16/2002

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

TRAN, LOUIS B

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,789

Applicant(s)

WHITMAN ET AL.

Examiner

Louis B Tran

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6,8,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Page 25, line 14 of the specification describes Figure 9a as a second embodiment where 9a was already described as a first embodiment above.

Appropriate correction is required.

2. The abstract of the disclosure is objected to because the steps that are claimed in the invention are not described within the abstract while irrelevant structure is described having no relation to the claimed invention. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Claim Objections

3. Claims 2-5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 2-5 further limit an orifice that is not part of the surgical apparatus device.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 10-13, 14-18, 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 and 26 recites the limitation "stapler/cutter" in line 2 of the claims. It is unclear if stapler/cutter is meant to be stapler or cutter, stapler and cutter. Correction is required.

Claim 10 and 14 recites the limitation "the flexible shaft" inline 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear to what shaft is being referred since only an elongated shaft was described in claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9, 20-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk (5,314,436).

With respect to claim 1, Wilk anticipates the use of a surgical device comprising an elongated shaft having a first coupling 34 and a surgical instrument having a second coupling 46, the second coupling being complimentary to and configured to couple with the first coupling, wherein the elongated shaft is configured to be inserted into a body via a first orifice and the surgical instrument is configured to be inserted into the body via a second orifice and wherein the elongated shaft is configured to be coupled with the surgical instrument via the first coupling and the second coupling after the elongated shaft is inserted into the body via the first orifice and after the surgical instrument is inserted into the body via the second orifice as seen in Figure 4.

With respect to claim 2, Wilk anticipates wherein the first orifice includes at least one of a natural orifice, an incision, and cannula.

With respect to claim 3, Wilk anticipates wherein the second orifice includes at least one of a natural orifice, an incision, and cannula.

With respect to claim 4, Wilk anticipates wherein each of the first orifice and the second orifice includes at least one of a natural orifice, an incision, and a cannula.

With respect to claim 5, Wilk anticipates wherein the first orifice is different from the second orifice.

With respect to claim 6, Wilk anticipates wherein the surgical instrument includes a surgical stapler instrument.

With respect to claim 7, Wilk anticipates wherein the surgical instrument includes a surgical stapler or cutter instrument.

With respect to claim 8, Wilk anticipates wherein the surgical instrument includes an anastomosis instrument.

With respect to claim 9, Wilk anticipates wherein the flexible shaft and the surgical instrument coupled to the flexible shaft are configured to be withdrawn from the body via the first orifice as described in column 4, lines 26-40.

With respect to claim 20, Wilk anticipates the steps of (a) inserting a flexible shaft into the body via first orifice, the flexible shaft having a first coupling, (b) inserting a surgical instrument into the body via a second orifice, the surgical instrument including a second coupling complimentary to and configured to couple with the first coupling and (c) coupling the flexible shaft and the surgical instrument via the first coupling and the second coupling after the inserting steps (a) and (b) as seen in Figure 4 described in column 4, lines 15-45.

With respect to claim 21, Wilk anticipates wherein the flexible shaft and the surgical instrument are coupled in the coupling step (c) intracorporeally.

With respect to claim 22, Wilk anticipates the step of forming a surgical procedure after the coupling step (c) as described in column 4 lines 5-15.

With respect to claim 23 and 24, Wilk anticipates wherein the surgical procedure includes a tissue stapling and cutting procedure.

With respect to claim 25, Wilk anticipates wherein the surgical procedure includes an anastomosis procedure.

With respect to claim 26, Wilk anticipates wherein the surgical instrument includes at least one of a surgical stapler instrument, a surgical stapler or cutter instrument and an anastomosis instrument.

In reference to claim 27 Wilk anticipates the step of withdrawing the coupled flexible shaft and surgical instrument via the first orifice as in column 4, lines 37 and 38.

In reference to claim 28, Wilk anticipates wherein the first orifice includes at least one of a natural orifice, an incision, and a cannula.

In reference to claim 29, wilk anticipates wherein the second orifice includes at least one of a natural orifice, an incision, and a cannula.

In reference to claim 30, Wilk anticipates wherein each of the first orifice and the second orifice includes at least one of a natural orifice, an incision and a cannula.

With respect to claim 31, Wilk anticipates wherein the first orifice is different from the second orifice as seen in Figure 4.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,314,436) in view of Adams et al. (6,119,913).

Wilk discloses the invention substantially as claimed including the above but does not expressly show wherein the surgical instrument includes at least one movable element, the flexible shaft including at least one rotatable drive shaft configured to effect movement of the at least one movable element.

However, Adams et al. teaches the use of wherein the surgical instrument includes at least one movable element 20, a shaft including at least one rotatable drive shaft 24 configured to effect movement of the at least one movable element 20 (as in claim 10), wherein the surgical instrument includes a first movable element 20 and a second movable element 36, the shaft including a first rotatable drive shaft 22 configured to effect movement of the first movable element and a second rotatable drive shaft 24 configured to effect movement of the second movable element seen in Figure 5 (as in claim 14), wherein a first coupling 717 and second coupling 719 are configured to couple the first movable element 20 and the first rotatable drive shaft 724' and to couple the second movable element and the second rotatable drive shaft 722' (as in claim 15), for the purpose of closing an anvil with a stapling portion as described in column 8, lines 5-25.

Adams et al. also teaches a device wherein a first coupling (tip of 717) and second coupling 719 are configured to couple the at least one movable element 720 and the at least one rotatable drive shaft 724' as described in column 10, line 12 for the purpose of connecting two ends (as in claim 11). Adams also teaches a device further comprising an electro mechanical driver device configured to drive at least one rotatable drive shaft (as in claim 12), wherein the electromechanical driver device includes a motor system configured to drive the at least one drive shaft (as in claim 13), and a device further comprising an electromechanical driver device configured to drive the first rotatable drive shaft and the second rotatable drive shaft as seen in Figure 1 (as in claim 16), wherein the electro mechanical driver device includes a motor system configured to drive the first rotatable drive shaft and the second rotatable drive shaft (as in claim 17), wherein the motor system includes a first motor configured to drive the first rotatable drive shaft and a second motor configured to drive the second rotatable drive shaft (as in claim 18) and wherein the flexible shaft includes a steering device 16 configured to steer a distal end of the elongated shaft (as in claim 19) all described in column 6, lines 35-37.

Therefore, it would have been obvious to one having ordinary skill in the art to provide Wilk with a rotatable closure element system in order to close an anvil for stapling.

Conclusion


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

lbt
December 6, 2002



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700